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*In re* Application of:  
BEGG, MICHAEL COLIN  
Serial No.: 10/812,917  
Filed: Mar. 31, 2004  
Docket: 34-125  
Title: MANUFACTURE OF SHIM WINDINGS

DECISION ON PETITION

This is a decision on the petition filed on Sep. 11, 2008 by which petitioner requests reconsideration and withdrawal of the restriction requirement mailed Apr. 5, 2006, and that non-elected claims 5, 6 and 8-10 be rejoined, if generic claims 1 and 6 are determined to be allowable. Claims 1-4 and 6-7 were elected for prosecution. Non-elected claims 5 and 8-10 stand withdrawn from consideration. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **GRANTED IN PART**.

A review of the record reveals that in response to the amendment of Aug. 3, 2006, a second restriction requirement, mailed on Oct. 13, 2006, was made between two disclosed and claimed related inventions: I) Claims 5 and 10, drawn to a product of an MRI shim coil, classified in class 336, subclass 200; and II) Claims 1 through 4 and 6 through 9, drawn to a process of making an MRI shim coil, classified in class 29, subclass 602.1. In the restriction requirement, additionally, an election of species was required among the Species A, B and C. On Nov. 13, 2006, the applicant elected, with traverse, the Group II invention and Species A which is directed to claims 1-4 and 6-7 for examination. Since the second restriction requirement is same as the first restriction requirement mailed on Apr. 5, 2006, then, this petition will only address the later restriction requirement of Oct. 13, 2006.

In judging the propriety of the restriction requirement, the related inventions, as claimed, must be shown to be distinct. See MPEP 802.01. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be used to make another and

materially different product or (2) the product as claimed can be made by another and materially different process. See MPEP 806.05(f)<sup>1</sup>.

In the instant application, the distinctness between the claimed inventions was justified in that the product as claimed can be made by another and materially different process, such as one that forms the required coil pattern by deposition and coating techniques, e.g. plating, CVD, etc., as opposed to cutting or punching of conductive material, as required by Group II.

On Nov. 13, 2006, the applicant traversed the rationale set forth above by basically arguing that the claimed product in claims 5 and 10 as manufactured by the methodology of the independent claim 1 cannot be made by a materially different process as alleged by the examiner, e.g., by a deposition and/or coating technique. The applicant is essentially saying that the examiner has not met the required burden of demonstrating that the product as claimed can be made by another materially different process. The applicant also stated that there would be no distinction between the method of making claims and the product claims. In the current petition, petitioner also argues the product of the process claims 5 and 10 can only be made by the claimed process of the respective parent claims 1 and 6. In the Office action of Feb. 15, 2007, the examiner rebutted these arguments by stating that the final structure of the product by process claims in Group I is not limited to the process steps recited in Group II because product by process claims are not limited to the manipulations of the recited steps in accordance with MPEP § 2113.

The examiner only has to show one-way distinction in accordance with MPEP § 806.05(f). As pointed out by the examiner the product as claimed can be made by another and materially different process, such as by deposition and coating techniques, e.g. plating, CVD, etc., as opposed to cutting or punching of conductive material, as required by Group II. Other alternative methods are possible as well, for example, extruding the metal and forming into a coil during the extrusion process. Further formulating in any of the above suggested processes can be enhanced by machining such as grinding or stretching and compression techniques. For applicant to state unequivocally that the claimed method is unique and that desired properties are provided that cannot be duplicated within the claimed product by other methods would appear unlikely particularly when no unique properties are seen or have been claimed that cannot be duplicated by other methods. Cutting and punching, per se, are not unique operations by themselves and certainly if some unique property is caused in the forming of the shim coil that other methods cannot duplicate, none is seen presently, and again, none is claimed.

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<sup>1</sup> MPEP § 806.05(f) [R-5] Process of Making and Product Made A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process. Allegations of different processes or products need not be documented. A product defined by the process by which it can be made is still a product claim (In re Bridgeford, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention. If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.


In addition, the examiner required an election of species between the embodiments represented by Species A, B and C (claims 7, 8 and 9, respectively). In this regard, petitioner correctly points out that if the generic claim 6 is found allowable, then, dependent claims 8 and 9 would be rejoined and also allowable (see last paragraph of page 3 of the Office action of Oct. 13, 2006). With regard to the non-elected product by process claims 5 and 10, they will not be rejoined because they are found to be independent or distinct from the process claims 1 and 6 in accordance with MPEP 806.5 (f).

#### Conclusion

For the reasons outlined above, the restriction requirement promulgated on Oct. 13, 2006 is in accordance with proper Office procedure. Therefore, the examiner's restriction requirement is proper. The requested relief to withdraw the restriction requirement under MPEP 806.05(f) will not be granted. The requested relief for rejoinder of non-elected claims 8 and 9 upon the allowance of the generic claim 6 is granted.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3729 for further consideration of amendment filed on Sep. 11, 2008. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

Accordingly, the petition is GRANTED IN PART.

  
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Frederick R. Schmidt, Director  
Technology Center 3700